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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,287	07/09/2003	Hiroyuki Takahashi	16816	9906

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EXAMINER	
JOHNSON III, HENRY M	
ART UNIT	**PAPER NUMBER**
3739	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/616,287	TAKAHASHI, HIROYUKI	
	Examiner	Art Unit	
	Henry M. Johnson, III	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 December 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *33-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *33-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *11/21/05* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Response to Arguments

Applicant's arguments filed December 18, 2006 have been fully considered but they are not persuasive.

While the applicant can indeed be a lexicographer, doing so at a point other than the initial prosecution is problematic. First, the term "judging" does not add to the patentability in that the prior art discloses a judging and/or identification means in the form of processors. Second, the claims now lack antecedent basis in the specification. Applebaum et al. specifically disclose the need to identify simultaneous operation (and by doing so, prohibiting simultaneous operation), thereby enabling the inherent capability of the processor to perform such function. The Whitman et al. reference enables the identification or judging function by teaching instruments with memory modules with instrument data that must be processed by a driving device.

The operation of multiple surgical devices is common in the art and the safety considerations associated with multiple devices is well known. Applebaum et al. clearly recognize such considerations in providing methodology for allowing or not allowing devices to operate together (synchronously) via communications links between the devices/controllers.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the term "judging portion" is not defined in the specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 33-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "judging portion", in claim 33 is new matter not in the initial disclosure. It appears this term has replaced the "identification portion" used previously.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 33-35 and 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,117,126 to Applebaum et al. in view of U.S. Patent 6,793,652 to Whitman et al. Applebaum et al. teach a surgical system with independent microprocessor control of a plurality of surgical instruments with communications between the surgical instruments (abstract). The instruments (Fig. 2, #19) each have a microprocessor interface module (Fig. 2, # 13) connected to a bus for communications to a main computer unit (Fig. 2, # 271). The microprocessors are interpreted as control units and by definition are programmable and thus are capable of decision making regarding synchronization based on the program code as suggested by Applebaum et al. in describing how instruments may or may not operate simultaneously. Applebaum et al. teach it may be desirable to prevent certain instruments from operating simultaneously for safety reasons. For example, a phacoemulsification instrument is disabled by the bipolar coagulation instrument when the latter is being used and vice-versa. In contrast, the aspiration

function is needed during phacoemulsification or phacofragmentation (Col. 18, lines 10-20). Thus, Applebaum et al. clearly teach a permission/no permission capability. The identification of each module is known to the system as are the operating parameters of the module and its instrument (Col. 20, lines 55-60). Panel controls (switches) or a foot switch (Fig. 2, # 15) may operate the instruments. It is inherent that the processor would known the status of the control panel switches. The modules and the central computer make up a control device. While Applebaum et al. teach the identification of the instruments by identification of control modules, a dynamic identification is not disclosed. Whitman et al. teach a surgical system wherein data on the instrument is stored in memory when it is attached (Col. 10, lines 5-15). In addition to the serial number of the instrument, usage data is also provided. Clearly, if an instrument were disconnected or exchanged, the identification information would change, providing new inputs to the control units that determine synchronous operations. This enable the process to identify or judge what instrument is connected. It would have been obvious to one having ordinary skill in the art at the time the invention was made to sense the instrument when it is attached as taught by Whitman et al. in the system of Applebaum et al. when instruments are likely to be interchanged or replaced to insure safety of operations. The usage parameters included in the Whitman et al.

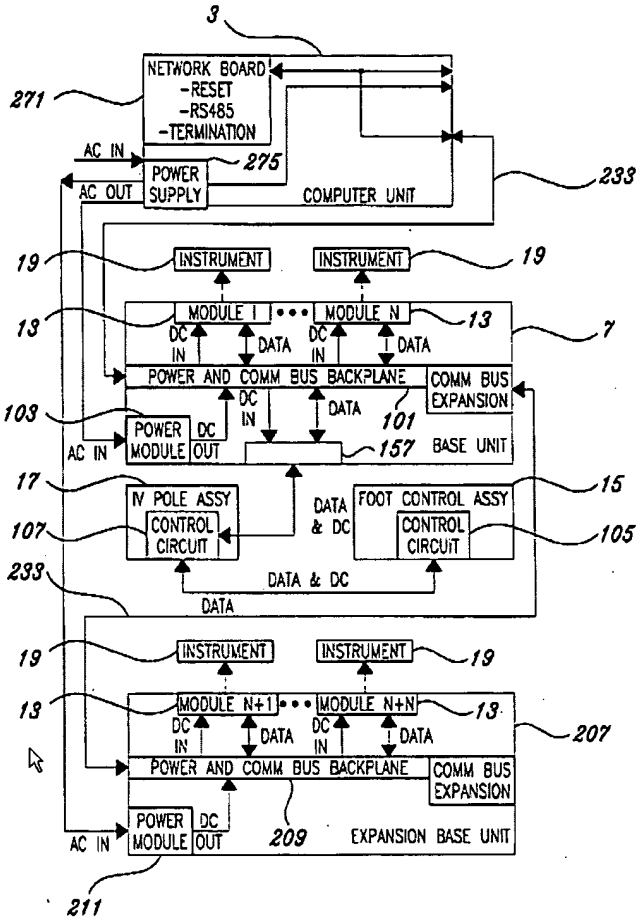

figure 2

identification information provides ample motivation when the operation of multiple devices must be coordinated for safety considerations.

Claims 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,117,126 to Applebaum et al. in view of U.S. Patent 6,793,652 to Whitman et al. as applied to claim 34 above, and further in view of U.S. Patent 5,502,726 to Fischer. Applebaum et al. and Whitman et al. are discussed above, but do not disclose timeouts. The use of timeout circuits and watchdog timers is well known in the art as evidenced by the Fischer patent that teaches a medical network that uses a watchdog timer (Fig. 5, # 526) to check for timeliness of data transfers and to initiate a program sequence in the event of a timeout. Watchdog timers are designed to detect abnormal conditions by looking for a recurring signal. Action is initiated if the signal is not detected. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the timeout circuits as taught by Fischer in the system Applebaum et al. in view of Whitman et al. to insure system integrity using a technique pervasive in the art. The safety concerns of surgery are clearly known to one of skill in the art and such person would select specific algorithms within a system processor to implement such safeguards. The prior art clearly discloses simultaneous operation and instrument identification. The manner of implementation is an obvious design choice.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry M. Johnson, III whose telephone number is (571) 272-4768. The examiner can normally be reached on Monday through Friday from 6:00 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Henry M. Johnson, III
Primary Examiner
Art Unit 3739